

REMARKS/ARGUMENTS

The Office Action mailed July 29, 2004 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-30. Applicant has amended all of the independent claims, claims 1, 10, 17, and 24.

35 USC 112 Rejection

In numbered paragraph 3 of the Office Action mailed July 29, 2004, claim 1 was rejected under 35 USC 112 as indefinite because it includes both the limitation "means for compressing a media signal" and "data compression means coupled to receive and compress the media signal." Claims 2-9 were rejected for being dependent on rejected claim 1.

Claim 1 has been amended to change the "means for compressing a media signal" to "acquisition means for acquiring a media signal." With this amendment it is clear that there are two different means in claim 1. Applicant believes he has provided a full and complete response to the rejection of claims 1-9 under 35 U.S.C. 112 stated in numbered paragraph 3 of the Office Action mailed July 29, 2004.

35 USC 103 Rejection - Paragraph 6 of Office Action

In numbered paragraph 6 of the Office Action mailed July 29, 2004, claims 1-5, 7, 9-14, 16-21, 23-28, and 30 were rejected under 35 USC 103(a) as allegedly being unpatentable over the primary Noll et al reference (U.S. Patent No. 5,732,138) in view of the secondary Koopman, Jr. reference (U.S. Patent No. 5,757,923) and further in view of the tertiary Borza et al reference (U.S. Patent No. 6,215,874).

Applicant has amended all of the independent claims, claims 1, 10, 17, and 24, and submits that all of the claims presented for examination are patentable over the primary Noll et al reference, the secondary Koopman, Jr. reference, and the tertiary Borza et al reference; and any legitimate combination of the three references.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) include "Ascertaining the differences between the prior art and the claims at issue."

The differences between the primary Noll et al reference and Applicants' invention are that the primary Noll et al Reference does not show the following elements of Applicant's amended independent claims 1, 10, 17, and 24:

"acquisition means for acquiring a media signal that has the capacity of containing random noise that is completely unpredictable from one moment to the next," or

"acquiring a media signal, said media signal having the capacity of containing random noise that is completely unpredictable from one moment to the next," or

"data compression means coupled to said acquisition means to receive and compress said media signal containing random noise that is completely unpredictable from one moment to the next into a compressed data stream," or

"compressing said media signal, said media signal having the capacity of containing random noise that is completely unpredictable from one moment to the next," or

"data acquisition means coupled to said data compression means to receive and select a set of data from the compressed data stream," or

"selection means coupled to said data compression means for selecting a set of data from the compressed data stream," or

“selecting a set of data from the compressed media signal,” or

“hashing means coupled to said data acquisition means to receive and hash the set of data into a keyword.”

The Noll et al reference fails to disclose Applicant’s claim elements listed above. Applicant’s claim elements include the limitation, “a media signal that has the capacity of containing random noise that is completely unpredictable from one moment to the next.” The Noll et al reference states, “First, chaotic systems can be completely or partially predicted over small amounts of time.... Furthermore, the behavior of chaotic systems can be far from completely random... All of the above problems arise because the behavior of a chaotic system may not be completely random.” (Col. 2, lines 7-21 Noll et al Reference) The Noll et al reference discloses “an apparatus and method for producing a seed for a pseudo-random number generator from hashing the digitization of a chaotic source.” (Col. 1, lines 8-11 Noll et al Reference)

Since the Noll et al reference is limited to a “chaotic source” the Noll et al reference system can not be modified to include Applicant’s claim elements, “acquisition means for acquiring a media signal that has the capacity of containing random noise that is completely unpredictable from one moment to the next,” or “data compression means coupled to said acquisition means to receive and compress said media signal containing random noise that is completely unpredictable from one moment to the next into a compressed data stream.” The Noll et al reference teaches away from any such modification.

Further, there is no suggestion or motivation for combining the primary Noll et al reference with the secondary Koopman, Jr. reference and the tertiary Borza et al reference. Under MPEP §2142, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the references or to combine reference teachings. It should be noted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Since there is no suggestion or motivation for combining the primary Noll et al reference with the secondary Koopman, Jr. reference and the tertiary Borza et al reference to produce Applicant's invention defined by amended claims 1-5, 7, 9-14, 16-21, 23-28, and 30, a 35 U.S.C §103(a) rejection of Applicant's amended claims 1-5, 7, 9-14, 16-21, 23-28, and 30 is unsupported by the prior art and should be withdrawn.

35 USC 103 Rejection - Paragraph 7 of Office Action

In numbered paragraph 7 of the Office Action mailed July 29, 2004, claims 6, 8, 15, 22, and 29 were rejected under 35 USC 103(a) as allegedly being unpatentable over the primary Noll et al reference (U.S. Patent No. 5,732,138) in view of the secondary Koopman, Jr. reference (U.S. Patent No. 5,757,923) and further in view of the tertiary Borza et al reference (U.S. Patent No. 6,215,874) and further in view of the quaternary Owashi et al reference (U.S. Patent No. 6,363,210).

Applicant has amended the independent claims, claims 1, 10, 17, and 24, and submits that claims 6, 8, 15, 22, and 29 that are dependent upon the independent claims are patentable over the primary Noll et al reference, the secondary Koopman, Jr. reference, the tertiary Borza et al reference, and the quaternary Owashi et al reference; and any legitimate combination of the four references.

The differences between the primary Noll et al reference and Applicants' invention are set out above in connection with Applicant's response to the

rejection of numbered paragraph 6. The Noll et al reference fails to disclose Applicant's claim elements listed above. Applicant's claim elements include the limitation, "a media signal that has the capacity of containing random noise that is completely unpredictable from one moment to the next." The Noll et al reference states, "First, chaotic systems can be completely or partially predicted over small amounts of time.... Furthermore, the behavior of chaotic systems can be far from completely random.... All of the above problems arise because the behavior of a chaotic system may not be completely random." (Col. 2, lines 7-21 Noll et al Reference) The Noll et al reference discloses "an apparatus and method for producing a seed for a pseudo-random number generator from hashing the digitization of a chaotic source." (Col. 1, lines 8-11 Noll et al Reference)

Since the Noll et al reference is limited to a "chaotic source" the Noll et al reference system can not be modified to include Applicant's claim elements, "acquisition means for acquiring a media signal that has the capacity of containing random noise that is completely unpredictable from one moment to the next," or "data compression means coupled to said acquisition means to receive and compress said media signal containing random noise that is completely unpredictable from one moment to the next into a compressed data stream." The Noll et al reference teaches away from any such modification.

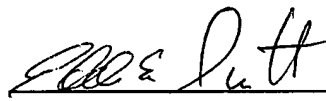
Further, there is no suggestion or motivation for combining the primary Noll et al reference with the secondary Koopman, Jr. reference, the tertiary Borza et al reference, and the quaternary Owashi et al reference. Under MPEP §2142, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. It should be noted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Since there is no suggestion or motivation for combining the primary Noll et al reference with the secondary Koopman, Jr. reference, the tertiary Borza et al reference, and the quaternary Owashi et al reference to produce Applicant's invention defined by claims 6, 8, 15, 22, and 29, a 35 U.S.C. §103(a) rejection of Applicant's claims 6, 8, 15, 22, and 29 is unsupported by the prior art and should be withdrawn.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action mailed July 29, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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